

## **REMARKS**

### **I. Introduction**

Claims 37 to 72 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant thanks the Examiner for indicating that the Drawings filed on June 19, 2009 have been accepted.

### **II. Rejection of Claims 37-48, 64-66 and 68-72 under 35 U.S.C. § 103(a)**

Claims 37-48, 64-66 and 68-72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,386,872 (“Shimizu”) in view of U.S. Patent No. 6,741,977 (“Nagaya”). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112;

emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 37 recites, in relevant parts, “exchanging data between the data memory of the capturing device and the at least one recording device, whereby **a virtual data memory is formed for the capturing device** by operational association between the data memory of the capturing device and the at least one recording device; **at the capturing device, receiving a request from a user to access the exchanged data, wherein the request does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory;** and responsive to the request, retrieving the exchanged data stored on the virtual data memory, **the retrieving occurring at the capturing device.**” Claims 64 and 72 recite features substantially similar to the above-recited features of claim 37.

The Examiner contends that col. 9, lines 4-34 of Nagaya disclose the limitation that **“the request does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory.”** The cited section of Nagaya refers to the retrieving of selectively recorded images in response to a search request that specifies a search condition. As explained in col. 8, lines 42-61 of Nagaya, image recording occurs as follows: (i) captured images are temporarily stored in a memory 170 of a recording/playback apparatus; (ii) simultaneously, the images are transferred to a video memory 118 associated with a display 210 so that the images are displayed while being stored; (iii) based on monitored event information and control data, images to be recorded are selected from among the images transferred to the memory 118; and (iv) the selected images are recorded in an auxiliary storage unit 160.

First, as recited in claim 37, the claimed “request” is a “request . . . **to access the exchanged data,**” i.e., the actual data **exchanged between the data memory of the capturing device and the recording device**. Although the Examiner considers the search request to be equivalent to **a request that does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory,** the search request is clearly not equivalent to a request for exchanged data; instead, the search request of Nagaya is a request to access data that is not the result of such an exchange. Since claim 37 provides that the **retrieving of “the exchanged data” occurs at the capturing**

device, and the cited section of Nagaya refers to retrieving images for display at the display 210, the Examiner appears to be suggesting that the combination of the camera 200, the recording/playback apparatus 100 and the display 210 collectively forms a single “capturing device,” in which case Nagaya does not disclose a **recording device separate from a capturing device**. In this regard, it should be noted that (as shown in Fig. 2) the auxiliary storage unit 160 and the memory are both part of the recording/playback apparatus 100. Therefore, the “capturing device” of Nagaya does not have a **data memory separate from a recording device**. Consequently, Nagaya also does not disclose an **exchange of data** between a data memory and a recording device. It also follows that **there is nothing for the request to differentiate between** in the system of Nagaya, since the data can only be stored in one place—namely, the auxiliary storage unit 160, and since there was never an exchange to begin with.

Second, although the Examiner maintains that Shimizu discloses a **virtual memory**, it should be noted that neither Shimizu nor Nagaya discloses **a recording device with a data memory for storing images, together with a separate recording device, also for storing the images**. As pointed out above, Nagaya only stores images in the auxiliary storage unit 160 of the recording/playback apparatus 100. In Shimizu, data is immediately transmitted from a video camera to a storage server, with only lost packets being temporarily stored at video camera for the purpose of retransmitting the lost packets. Thus, both Shimizu and Nagaya refer to **a single storage memory**. This is exactly the opposite of a virtual memory which, as provided in the claims, forms a **secondary storage source** for the data memory of the capturing device.

For at least the foregoing reasons, the combination of Shimizu and Nagaya fails to render obvious claims 37, 64 and 72, and their dependent claims 38-48, 65, 66 and 68-71. Withdrawal of the obviousness rejection is respectfully requested.

### **III. Rejection of Claims 49, 51-63 and 67 under 35 U.S.C. § 103(a)**

Claims 49, 51-63 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Nagaya and U.S. Patent No. 5,724,475 (“Kirsten”). Applicant respectfully submits that the pending claims are patentable over the applied references for at least the following reasons.

Claims 49, 51-63 and 67 are ultimately dependent on claim 37 or 64. As noted above, the combination of Shimizu and Nagaya fails to render obvious parent claims 37 and 64. In addition, the teachings of Kirsten do not remedy the deficiencies of Shimizu and Nagaya as applied against claims 37 and 64, let alone suggest the limitations of dependent claims 49, 51-63 and 67. Accordingly, claims 49, 51-63 and 67 are allowable over the applied combination of references.

In view of all of the foregoing, withdrawal of the obviousness rejection of claims 49, 51-63 and 67 is respectfully requested.

**IV. Rejection of Claim 50 under 35 U.S.C. § 103(a)**

Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Nagaya, Kirsten and U.S. Patent No. 6,954,859 (“Simerly”). Applicant respectfully submits that the pending claims are patentable over the applied references for at least the following reasons.

Claim 50 is ultimately dependent on claim 37. As noted above, the combination of Shimizu, Nagaya and Kirsten fails to render parent claim 37 obvious. In addition, the teachings of Simerly do not remedy the deficiencies of Shimizu, Nagaya and Kirsten as applied against claim 37, let alone suggest the limitations of dependent claim 50. Accordingly, claim 50 is allowable over the applied combination of references.

In view of all of the foregoing, withdrawal of the obviousness rejection of claim 50 is respectfully requested.

V. **Conclusion**

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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By: SONG LEE for Gerard Messina  
Gerard A. Messina  
(Reg. No. 35,952)  
KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**